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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/663,044	09/13/2003	David J. Laverick	702.270	1972
38933	7590	12/12/2007		
GARMIN LTD. C/O GARMIN INTERNATIONAL, INC. ATTN: Legal - IP 1200 EAST 151ST STREET OLATHE, KS 66062			EXAMINER DIACOU, ARI M	
			ART UNIT 3663	PAPER NUMBER
			MAIL DATE 12/12/2007	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/663,044	Applicant(s) LAVERICK ET AL.	
	Examiner Ari M. Diacou	Art Unit 3663	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 26 September 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,3-8,13,14 and 30-46 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,3-8,13,14 and 30-46 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date: _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date: _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Continued Prosecution Application

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 9-26-2007 has been entered.

Response to Arguments

2. In the remarks filed 9-26-2007, applicant argued the following:
- A. On page 10, that the language of the claims has been amended, and overcomes the 112 rejections.
 - B. On page 11, that the cited art does not teach all of claimed limitations.
3. Argument A is convincing, the rejections are hereby withdrawn.
4. Argument B is moot in view of the new grounds of rejection, which has been necessitated by amendment.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claims 1, 3-4, 14, 31-33, 38 and 40-41 are rejected under 35 U.S.C. 102(b) as being anticipated by Schoenfish et al. (USP No. 6370037).

- Regarding claims 1, Schoenfish discloses a navigation assembly for use in a vehicle comprising:
 - a navigational device; and [Fig. 1, #12]
 - a carrying case sized and configured to removably fit substantially within a tray [Fig. 1, #14] recessed downwardly within a top surface of a dashboard running along a windshield of the vehicle [Col. 2, lines 14-16] and configured to substantially enclose the navigational device, [Figs 2 and 3]
 - wherein the case is configured to conform to the tray. [Fig. 2]
- Regarding claims 31, Schoenfish discloses a navigation assembly for use in a vehicle comprising:
 - a navigational device; and [Fig. 1, #12]
 - a carrying case [Fig. 1, #14] sized and configured to conform to a tray [Fig. 1, #10] recessed downwardly within a top surface of a dashboard running along a windshield of the vehicle [Col. 2, lines 14-16],
 - wherein the carrying case may be removed from the tray with the navigational device substantially enclosed therein. [Fig. 2]
- Regarding claim 40, Schoenfish discloses a navigation assembly for use in a vehicle comprising:

- a navigational device; and [Fig. 1, #12]
 - a carrying case configured to substantially enclose the navigational device, [Fig. 1, #14]
 - the case being sized and configured to fit within a tray [Fig. 1, #10] on a dashboard of the vehicle such that the case does not move within the tray and is held firmly in place [Col. 2, lines 14-16], by gravity [Col. 3 line 53 says that 34 tapers downwardly, suggesting that surface 24 has at least a component that is perpendicular to gravity] and the close conformity of the case to the tray. [Col. 2, lines 14-16],
- Regarding claim 3, 41 and 32, Schoenfish discloses [Col. 2, lines 14-16].
 - Regarding claims 14 and 38, the limitations thereof are inherent to all GPS devices disclosed by Schoenfish.
 - Regarding claims 4 and 33, Schoenfish discloses Col. 5, lines 10-18.

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

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1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

9. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

10. Claims 5-8, 30, 34-37, 39, 43 and 45-46 are rejected under 35 U.S.C. 103(a) as being unpatentable over Schoenfish as applied to claims 1, 31 and 40 above, and further in view of Trumbull (USP No. 6125030).

- Regarding claim 5, 34 and 45, Schoenfish discloses the invention with all the limitations of claims 1 and 31, but fails to disclose a lid. Trumbull teaches a compartment with a hinged lid that could be used to enclose the device of Schoenfish. Therefore, it would have been obvious to one skilled in the art (e.g. an optical engineer) at the time the invention was made, to place device of Schoenfish in the compartment of Trumbull, for the advantage of protecting the device of Schoenfish.

- Regarding claims 6 and 35 and 46, Schoenfish discloses [Col. 2, lines 17-20].
- Regarding claims 7, 36 and 43, Schoenfish's device has a speaker, therefore, it would be contained in the case of Trumbull in the obvious combination described above.
- Regarding claims 8, 30, 37 and 39, Trumbull's device has a recessed base that would enclose the navigational device, and the speaker enclosed therein.

Therefore, both would be positioned within the base of the case.

11. Claims 13, 37 and 44 are rejected under 35 U.S.C. 103(a) as being unpatentable over Schoenfish as applied to claims 1 and 31 above, and further in view of Hsu (USP No. 5812369). Schoenfish discloses the invention with all the limitations of claims 1, 31 and 40, but fails to disclose a hinged lid containing the GPS and the speakers. Hsu teaches a laptop wherein the display [#12] and speaker [#14] are both positioned within a lid [#30] of the case, such that when the case is open, the navigational device is in a viewing position [Fig. 1]. Therefore, it would have been obvious to one skilled in the art (e.g. an ergonomic engineer) at the time the invention was made, to use the presentation strategy of Hsu, for the advantage of covering the screen for protection when not in use.

12. Claims 30, 39 and 42 are rejected under 35 U.S.C. 103(a) as being unpatentable over Schoenfish (and Hsu) as applied to claims 1, 31 and 40 above, and further in view of Iredale (USP No. 6,392,677). Schoenfish discloses the invention with all the

limitations of claims 1, 31 and 40, but fails to disclose the triangular setup claimed.

Iredale teaches :

- wherein the carrying case includes a base and a hinged [178] lid [128],
- such that when the navigational device [70] is pivoted to a flat, nesting position within the case, the lid is operable to enclose the navigational device, [#62] [#78/#82]
- and when the navigational device is pivoted upwards in a viewing position, the lid [Fig. 2, #146] is operable to pivot upwards and rest generally against a top of the navigational device [Fig. 2, #70]

Therefore, it would have been obvious to one skilled in the art (e.g. an ergonomic engineer) at the time the invention was made, to use the display strategy of Iredale with the idea of Schoenfish, for the advantage of having an improved clamshell type housing that facilitates adjustment of the display screen to a comfortable viewing angle.

Conclusion

13. The references made herein are done so for the convenience of the applicant. They are in no way intended to be limiting. The prior art should be considered in its entirety.

14. The prior art which is cited but not relied upon is considered pertinent to applicant's disclosure.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ari M. Diacou whose telephone number is (571) 272-5591. The examiner can normally be reached on Monday - Friday, 8:30 am - 5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jack Keith can be reached on (571) 272-6878. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/AMD/

10-Dec-07

/Deandra M. Hughes/
Primary Examiner
AU3663